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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/020,616
Filing Date: December 13, 2001
Appellant(s): LENORE ET AL.

Greg O'Bradovich
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 20, 2006 appealing from the
Office action mailed May 4, 2006.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) **requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal**, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient for the following reasons.

Appellant states that claim 1 is directed to a method for managing legal information related to at least one legal matter in a system including a legal enterprise 10 and a storage system 20 coupled through a network 36 as shown in Figure 1 and

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discussed on page 5, lines 5-21 in the specification. This statement is directed to the preamble of claim 1. As for the claim limitations, claim 1 is directed to:

storing legal information in a database associated with the storage system, said legal information including an evidentiary outline corresponding to said legal matter, the evidentiary outline including a party's position and a link to evidence stored in the database supporting the party's position, the link created by a contributor having authority to modify legal information in the database; and

providing the legal information to a client via the network.

Appellant identifies the invention as follows:

When a user contacts the storage system 20, the user is prompted for a user identification and password. Through user identification and password, the storage system 20 controls the level of interaction with legal information stored in database 24. Designated personnel of legal enterprise 10 have the discretion to set levels of access for all users, or subgroups of users. Contributors of legal information (e.g. personnel such as attorneys or paralegals of the legal enterprise 10) may submit or edit legal information as well as view existing legal information. Clients may view legal information, but generally cannot contribute or edit legal information. A user is identified as a contributor or a client through the user identification or password. In addition, access to legal information is limited on a matter-by-matter basis. A client can only view legal information for matters involving that client. Similarly, personnel with the legal enterprise may be limited to accessing legal information on only those matters with

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which the personnel is involved. Storage system 20 enforces the limits on access by requiring users to submit user identifications and passwords.

The Examiner asserts that none of the limitations discussed in the above paragraph is actually presented in independent claim 1. Many of the limitations discussed above are found in dependent claims.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4, 16-19, and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krachman (US 6,738,760) in view of Simpson et al (US 6,549,894) (hereinafter referred to as Simpson).

Referring to Claims 1, 16, and 30-33:

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Krachman discloses a method, system, and storage medium for managing legal information related to at least one legal matter in a system including a legal enterprise system and a remote system (Figures 2-3), the system comprising a storage system (24) (34) coupled via a network for communicating information (col. 4, lines 53-55 Figure 3 illustrates a network-based system; col. 4, lines 63-67 via the network 300), a database (24) (34), the method comprising:

storing legal information in a database associated with the storage system, said legal information including an evidentiary outline corresponding to the legal matter (Figures 1 and 7-13 Discovery), the evidentiary outline including a party's position and a link to evidence (Figure 1 (11) Deposition Transcripts etc.) stored in the database supporting the party's position (Figure 1 (11) Fact chronologies/issues); and providing the legal information to a user via the network (Figures 7-13; col. 4, lines 53-67).

While Krachman discloses a method and system for managing legal activity using artificial intelligence technology applied to computer databases and archives (col. 2; lines 11-18), Krachman does not explicitly disclose that the link ***is created by a contributor having authority to modify legal information.***

However, Simpson discloses a computerized docketing system for legal matters (col. 3, lines 36-47) wherein only authorized users are allowed access and wherein some users are given full read/write ability (thus the ability to modify) whereas others are given read only ability (col. 5, lines 36-48) and links to electronic intellectual property law forms programs (col. 5, lines 26-27).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the legal method and system of Krachman the ability to control access so that an administrator would have full read/write authority while others would be given read only authority as taught in Simpson for security purposes of allowing some users to browse screens without being able to make changes.

Referring to Claims 2, 17, and 34:

Simpson discloses determining if the user is a client having authority to view legal information in the database or the user has authority to modify legal information in the database (col. 5, lines 36-48 – For security purposes, only authorized users are allowed to access the docketing program. The System Setup screen (not shown) is used to set user security levels. For example, some users are given full read/write ability, whereas others are given read only ability. In a typical installation, a docketing administrator would be given full read/write authority, while responsible attorneys would be given read only authority. Thus, a docketing administrator could modify due dates and docket actions, but an attorney could only browse docket actions screens without being able to change any due dates, etc. The user verification screen shown in FIG. 2 is used to verify that a person attempting to use the program is authorized to do so).

Referring to Claims 3, 18, and 35:

Simpson discloses wherein the determining is based on a user identification and password (Figure 2 User Login and Password; The user verification screen shown in

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FIG. 2 is used to verify that a person attempting to use the program is authorized to do so).

Referring to Claims 4, 19, and 36:

Krachman discloses enabling a contributor to add further links to further evidence in the database (col. 3, lines 54-56 network can be linked to on-line legal services; col. 8, line 4-6 first generates index of potentially responsive documents, with coded, locked hyperlink to full text; col. 11, lines 40-58).

2. Claims 5-15, 20-28, and 37-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over claims Krachman and Simpson as applied to claim 1, 16, and 33 above, and further in view of Embracing the Virtual Office Concept: How Legal Anywhere Collatorator! Can Help, By David H. Griggs published February 2000 (hereinafter referred to as Griggs).

Referring to Claims 5-6, 20-21, and 37-38:

While Simpson discloses setting up different levels of access with some users given full read/write ability and others given read only (col. 5, lines 36-48), neither Krachman nor Simpson discloses enabling a user to edit a link to evidence in the database and restricting access to the legal information **if the user is a client**.

However, Griggs discloses restricting access to legal information if the user is a client. (page 2 Collaborator permits you to grant editing rights; page 2 you can collaborate with individuals outside of the firm – be they clients or outside co-counsel. Again, you can authorize or restrict access to anyone you wish and likewise limit access

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to certain areas for those who can access the site -Collaborator permits you to grant editing rights to other parties participating in the case/transaction (clients, co-counsel, colleagues)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the legal methods and systems of Krachman and Simpson the ability to grant editing rights and authorize or restrict access to anyone you wish while limiting access to certain areas for those who can access the site, such as clients, as taught in Griggs so as to create a secure/private extranet for each client/law firm you are working with and to eliminate the hassle of circulating documents via e-mail or fax and make new edits immediately available to all participants.

Referring to Claims 7-8, 22-23, and 39-40:

Griggs discloses wherein the contributor has access to legal information related to all of the plurality of legal matters and wherein the contributor has access related to a subset of all of the plurality of legal matters (page 2 you can collaborate with individuals outside of the firm – be they clients or outside co-counsel. Again, you can authorize or restrict access to anyone you wish and likewise limit access to certain areas for those who can access the site -Collaborator permits you to grant editing rights to other parties participating in the case/transaction (clients, co-counsel, colleagues).

Referring to Claims 9, 24, and 41:

Griggs discloses wherein the legal information is encrypted prior to transmission to the storage system (page 3 solutions is as secure as the current encryption levels allow).

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Referring to Claims 10-14, 25-29, and 42-46:

Krachman discloses wherein the evidence includes documents produced during discovery, response to interrogatories, deposition transcripts, audio files, and video files (Figures 7-9 and col. 4, lines 20-26).

Referring to Claim 15:

Krachman discloses wherein the evidentiary outline includes parties' position (Figure 1 (11) Facts/Issues).

(10) Response to Argument

Claims 1-4, 16-19, and 30-36 are Non-Obvious as to Krachman in view of Simpson

Appellant asserts that the rejection of claims 1-4, 16-19, and 30-36 as being unpatentable over Krachman in view of Simpson is improper because the Final Office action filed to establish a *prima facie* case of obviousness. Appellant asserts that for an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art. Appellant's argument is that all of the elements of appellant's claimed invention are not found in the prior art.

Claim 1 is directed to:

A method for managing legal information related to at least one legal matter in a system including a legal enterprise and a storage system coupled via a network, the method comprising:

storing legal information in a database associated with the storage system, said legal information including an evidentiary outline corresponding to said legal

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matter, the evidentiary outline including a party's position and a link to evidence stored in the database supporting the party's position, the link created by a contributor having authority to modify legal information in the database; and

providing the legal information to a client via the network.

Appellant states that *in embodiments of the invention the information in the database evidence supporting a party's position is inserted into the database and linked to by a contributor as described in at least page 7, lines 5-20 of appellant's specification.*

Appellant states that Krachman fails to teach or suggest this feature.

In response to appellant's argument that the references fail to show the above referenced features of appellant's invention, it is noted that the features in the embodiments of the invention which appellant relies (i.e., evidence supporting a party's position is inserted into the database) are not recited in claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant states that Krachman discloses artificial intelligence used to search documents based on a query wherein the search results are presented to the user as a series of links to documents as shown in Figure 10 (page 4 of the Appeal Brief).

Appellant asserts that Krachman, however, does not teach that links are created in the database between a party's position and evidence supporting that position. The Examiner respectfully disagrees with this assertion.

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The Examiner cites Figure 1 (11) as disclosing storing legal information in a database associated with a storage system. The claim limitation further reads that the legal information includes an evidentiary outline including a party's position and a link to evidence stored in the database supporting the party's position.

MPEP 2111 requires that claims must be given their broadest reasonable interpretation consistent with the supporting description without reading limitations from the specification into the claims. The Examiner asserts that the term "legal information" would encompass any legal information, including case name, a lawyer's summary, pleadings, fact chronologies/issues and deposition transcripts. The Examiner asserts that an "evidentiary outline" could be any evidence that is outlined or the heading as to the types of evidence presented in an outline form, for example, pleadings, proof of facts, fact chronologies/issues, investigation reports, deposition transcripts as shown in Figure 1 (11). The Examiner asserts that an "evidentiary outline including a party's position and a link to the evidence stored in the database supporting the party's position" could be pleadings (which disclose the party's position) fact chronologies, investigative reports or depositions (see col. 3, lines 40-56). Any assertion as to the parties position would be evidence of the party's position. A link to this evidence can simply be the case name, or a legal citation to case law. Moreover, Krachman discloses that the network can also be linked to on-line legal services such as Westlaw or Lexis in order to input the latest information relating to a legal issue (col. 3, lines 54-56). The Examiner asserts that the link to on-line legal services to the latest

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information relating to a legal issue would be "a link to evidence supporting a party's position".

The Merriam Webster Online dictionary defines the term "link" as:

Link

9 entries found for **link**.

To select an entry, click on it.

link[4, intransitive verb]	▲	Go
chain-link fence		
cross-link		
cuff link		
missing link		
hot link	▼	

Main Entry: **link** 🔊

Pronunciation: 'li[ng]k

Function: *noun*

Etymology: Middle English, of Scandinavian origin; akin to Old Norse *hlekk* chain; akin to Old English *hlanc* lank

1 : a connecting structure: as **a** (1) : a single ring or division of a chain (2) : one of the standardized divisions of a surveyor's chain that is 7.92 inches (20.1 centimeters) long and serves as a measure of length **b** : CUFF LINK **c** : BOND

3c d : an intermediate rod or piece for transmitting force or motion; *especially* : a short connecting rod with a hole or pin at each end **e** : the fusible member of an electrical fuse

2 : something analogous to a link of chain: as **a** : a segment of sausage in a chain **b** : a connecting element or factor

<found a *link* between smoking and cancer> **c** : a unit in a communication system **d** : an identifier attached to an element (as an index term) in a system in order to indicate or permit connection with other similarly identified elements

Thus, any connecting element or factor, identifier attached to an element in a system in order to indicate or permit connection with other similarly identified elements or documents is a link. Therefore, the Examiner asserts that any pleadings, proof of facts, or investigation reports that are filed under a case name would comprise a link to evidentiary evidence.

Appellant argues that Krachman teaches a search engine that relies on training of neural networks to access search results, which is in clear contrast to appellant's claimed invention that teaches, among other things, storing legal information in a database associated with the storage system, said legal information including an evidentiary outline corresponding to said legal mater, the evidentiary outline including a party's position and a link to evidence stored in the database supporting the party's position, the link created by a contributor having authority to modify legal information in the database.

The Examiner asserts that Krachman is directed to a method and system for providing electronic discovery on computer databases and archives using artificial intelligence to recover legally relevant data. It is the object of Krachman to provide electronic discovery for purposes of litigation, thus, to provide evidentiary evidence (col. 2, lines 66-67). Moreover, Krachman discloses that the electronic discovery server can be controlled by a third party supervisory body which will obtain input from both parties in order to control the discovery process performed by the present invention (col. 4, lines 53-62); thus, a link is created by a contributor (third party supervisory body) having authority to modify (control) legal information in a database).

Appellant further states that Simpson discloses "a computerized docketing system for legal mater wherein only authorized users are allowed to access and wherein some users are given full read/write ability whereas others are given read only ability". The appellant asserts that the cited sections on Simpson provide no teaching or suggestion of appellant's "link to evidence stored in the database supporting the

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party's position, the link created by a contributor having authority to modify legal information in the database". Appellant asserts that Simpson merely discloses an access feature to the Simpson database and not authority to modify legal information in the database of appellant's claimed invention. Furthermore, appellant asserts that Simpson's link is simply to forms. In contrast, appellant asserts that appellant's link is to "evidence stored in the database supporting the party's position" (from the evidentiary outline).

Simpson discloses a computerized docketing system for legal matters comprising a database operatively arranged to store information related to the legal matters (col. 3, lines 36-47). Simpson discloses levels of access wherein a docketing administrator (could be considered to be a contributor) can modify due dates and docket actions (legal information including evidentiary outlines corresponding to a legal matter). Simpson further discloses a File screen (Figure 4) used to enter and track information and data related to a matter to be docketed. The docket administrator (contributor) can enter various information such as client name and address, trademark, description of goods, class country of filing (evidentiary outline corresponding to a legal matter) and also specify the type of application being filed (e.g., intent to use, principal register, etc.) (the party's position) and link to evidence (client name) stored in the database supporting the party's position (col. 6, line 65 thru col. 7, line 12).

Simpson further discloses a link to electronic intellectual property forms (col. 5, lines 26-27). Thus, by the administrator (contributor) selecting one of the following modules, Simpson is providing a link to evidence stored in the database supporting the

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party's position (docketing trademark applications, docketing litigation matters), the link created by a contributor having authority to modify legal information (administrator can modify due dates and docket actions) in the database (col. 5, lines 6-47).

Appellant further states that Simpson's link is simply a link to forms. However, the Examiner considers links to legal forms to be a link to evidence supporting the appellant's position.

Appellant states that Krachman in view of Simpson has no reasonable expectation of success. However, the appellant has provided no evidence as to this assertion.

Moreover, the Examiner notes that appellant's invention is simply directed to storing and providing information. The type of information/data stored in the database does not functionally related to the steps of the method or the structure of the system. Therefore, the fact that the information includes an evidentiary outline including a party's position and a link to evidence, or that the link is created by a contributor, is determined to be non-functional descriptive data. Nonfunctional descriptive material cannot render non-obvious an invention that would have otherwise been obvious. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability.)

Claims 5-15, 20-28 and 37-46 are non-obvious over Krachman and Simpson in view of Griggs.

Appellant states that the rejection is improper because the Final Office action has filed to establish a *prima facie* case of obviousness. Appellant asserts that all of the

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elements of appellant's claimed invention are not found in the prior art, that the Examiner relies upon Griggs for disclosing different access rights for clients and contributors, and that Griggs fails to cure the deficiencies of Krachman in view of Simpson discussed above with reference to claim 1. Appellant asserts that Griggs is nothing more than marketing literature that provides no support or enablement for the product in which Griggs is marketing.

Griggs was cited for the limitation of enabling a user to edit a link to evidence in a database and restricting access to the legal information *if the user is a client*.

While Simpson discloses setting up different levels of access with some users given full read/write ability and others given read only with the docketing administrator having the ability to modify the due dates and docket actions (col. 5, lines 36-48), neither Krachman nor Simpson discloses enabling a user to edit a link to evidence in the database and restricting access to the legal information *if the user is a client*. However, Griggs teaches permitting the grant of editing rights and the collaboration with individuals outside a firm – be they *clients* or outside co-counsel. Griggs teaches that you can authorize or restrict access to anyone you wish and likewise limit access to certain areas for those who can access the site -Collaborator permits you to grant editing rights to other parties participating in the case/transaction (*clients*, co-counsel, colleagues) page 2).

Appellant states that Griggs merely makes a marketing assertion that editing grants can be granted to certain parties (clients, co-counsel, colleagues), but makes no disclosure related to “authority to modify legal information in the database,” wherein the

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authority is the creation of "a link to evidence stored in the database storing the party's position" of appellant's claimed invention". First, it is unclear what appellant means by the authority is the creation of " a link to evidence...".

Secondly, in response to appellant's arguments against the Griggs reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Griggs is cited in combination with Krachman and Simpson. As stated above, Simpson discloses setting up different levels of access with some users given full read/write ability and others given read only with the docketing administrator having the ability to modify the due dates and docket actions (col. 5, lines 36-48). Neither Krachman nor Simpson disclose enabling a user to edit a link to evidence in the database and restricting access to the legal information **if the user is a client**. However, Griggs discloses a document collaboration section of Collaborator, wherein one can make legal documents available for client and co-counsel review and receive feedback on specific provisions within the documents. Collaborator permits the granting of editing rights to other parties participating in the case/transaction (clients, co-counsel, colleagues). Collaborator requires a password to enter the site. The extranet portion of the Collaborator site is the area where one can collaborate with individuals outside the firm- be they clients or outside-counsel. Again, one can authorize or restrict access to anyone they wish, and likewise limit access to certain areas for secure/private extranet for each client/law firm you're working with, using a simple pull-down menu

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command. Each site resides behind a firewall that prevents access by unauthorized parties (page 2). Collaborator implements the easy-to-use security features, including token sessions, expiring session IDs, access and authentication control, URL verification, prompted password changes, and log-in auditing and tracking. Thus, the Examiner asserts that Griggs complies with the enablement requirement in that the subject matter is described in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Appellant states that with regard to claims 9, 24, and 41, the Office action asserts that Griggs provides appellant's limitation "wherein the legal information is encrypted prior to transmission to the storage system. However, appellant asserts that Griggs specifically does not provide appellant's subject matter of claims 9, 24, and 41.

Appellant states that Griggs states "is secure as the most current encryption levels allow. " Once again, appellant states that this is a fluffed marketing claim and does not state that "legal information is encrypted prior to transmission to the storage system".

The Examiner respectfully disagrees with appellant's assertion. Griggs, under the heading Security (page 3), states that confidentiality and security are critical to the success of any intranet/extranet venture. Griggs states that Legal Anywhere has taken extensive measures to ensure that client information within its intranet/extranet solutions is as secure as the most current encryption levels allow. Thus, the Examiner asserts that Griggs discloses that the legal information is encrypted and thus this would mean that any transmission would be encrypted, even a transmission to the storage system.

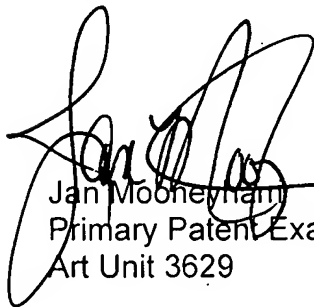
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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



Jan Mooneyham
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